

Notice of Allowability

Application No.

09/165,460

Examiner

Delia M. Ramirez

Applicant(s)

RINE ET AL.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to decision by BPAI rendered 11/23/2005.
2. ☒ The allowed claim(s) is/are 31,33-35,37-39,41-43,45 and 46 -see attached.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Art Unit: 1652

DETAILED ACTION

Status of the Application

Claims 31, 33-35, 37-39, 41-43, 45-46 are pending.

In view of the Board of Patent Appeals and Interferences decision regarding claims 31, 35, 37-39, 43, 45-46, the 35 USC 103(a) rejections previously applied are hereby withdrawn.

As previously indicated in the Final Action mailed on 12/29/2003, claims 33-34 and 41-42 were deemed allowable over the prior art of record but were objected to as they depend upon previously rejected base claims. These claims are no longer objected to in view of the decision by the Board of Patent Appeals and Interferences.

Examiner's Amendment

1. An informal Examiner's amendment to the specification appears below. This amendment is to add a specific reference to a prior application(s) in the first sentence of the specification (37 CFR 1.78).
2. Please enter the following amendments to the specification as follows:
3. In page 1, immediately after "Cross-reference to related applications", please replace lines 4-5 with the following sentence:

This application is a divisional of U.S. Application No. 08/902774, filed July 30, 1997, now abandoned, which claims the priority of U.S. Provisional Application Serial No. 60/023,491, filed August 7, 1996.

List of Allowed Claims

4. Due to the fact that the allowed claims are scattered within several amendments, to avoid any confusion at the time of printing, the Examiner is providing a complete list of the allowed claims as follows. It is noted that claims 31, 35, 37-39, 43, 45-46 as shown in the following list are those presented

Art Unit: 1652

by Applicant in page 8 of the Appeal Brief submitted 1/13/2004. Claims 33-34, 41-42 as shown in the following list are those presented by Applicant in the amendment filed 4/3/2001.

31. A recombinant expression vector comprising a promoter operably linked to an expressed polynucleotide which encodes a polypeptide and hybridizes under highly stringent conditions to a nucleic acid consisting of SEQ ID NO:1, wherein said polypeptide mediates the proteolytic removal of an AAX tripeptide from a prenylated CAAX protein and said highly stringent conditions comprise hybridization and wash conditions selected to be 5° C lower than the thermal melting point (T_m) for said nucleic acid at a defined ionic strength and pH.
33. A vector according to claim 31, wherein the polypeptide comprises SEQ ID NO:2.
34. A vector according to claim 31, wherein the polypeptide consists of SEQ ID NO:2.
35. A recombinant expression vector comprising a promoter operably linked to an expressed polynucleotide which encodes a polypeptide and hybridizes under highly stringent conditions to a nucleic acid consisting of SEQ ID NO:3, wherein said polypeptide mediates the proteolytic removal of an AAX tripeptide from a prenylated CAAX protein and said highly stringent conditions comprise hybridization and wash conditions selected to be 5° C lower than the thermal melting point (T_m) for said nucleic acid at a defined ionic strength and pH.
37. A vector according to claim 35, wherein the polypeptide comprises SEQ ID NO:4.
38. A vector according to claim 35, wherein the polypeptide consists of SEQ ID NO:4.
39. A recombinant cell transduced with the vector of claim 31.
41. A recombinant cell transduced with the vector of claim 33.
42. A recombinant cell transduced with the vector of claim 34.
43. A recombinant cell transduced with the vector of claim 35.
45. A recombinant cell transduced with the vector of claim 37.
46. A recombinant cell transduced with the vector of claim 38.

Art Unit: 1652

Reasons for Allowance

5. The following is an Examiner's statement of reasons for allowance. While the Examiner rejected claims 31 and 39 under 35 U.S.C. 103(a) as being unpatentable over Rose et al. (GenBank accession number Z49617, October 6, 1995) in view of Nozaki et al. (U.S. Patent No. 4,997,767, March 1991), and claims 35, 37-38, 43, 45 and 46 under 35 U.S.C. 103(a) as being unpatentable over Lye et al. (GenBank accession number Z49260, May 16, 1995) in view of Nozaki et al. (U.S. Patent No. 4,997,767, March 1991), the Board of Patent Appeals and Interferences have found claims 31, 35, 37-39, 43, 45-46 non-obvious over the prior art of record. Claims 33-34 and 41-42 are no longer objected since the base claims from which they depend have been found allowable by the Board of Patent Appeals and Interferences.

Conclusion

6. Claims 31, 33-35, 37-39, 41-43, 45-46 are allowed.

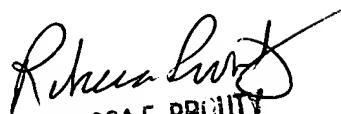
7. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (571) 272-0938. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (571) 272-0928. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Delia M. Ramirez, Ph.D.
Patent Examiner
Art Unit 1652

DR
January 30, 2006


REBECCA E. PROUTY
PRIMARY EXAMINER
GROUP 1800
1600